

Remarks

Claim 1-2, 5-8, 11-14 and 17-18 are pending.

Rejections Under 35 U.S.C. § 103

All pending claims stand rejected under Section 103 as being obvious over Biegelsen (6335084), Ueda (5801722) and Meunier (6582138).

Claims 1 and 7 have been amended to explicitly recite that the imaging device performs the sensing act. Amended Claim 1 recites an imaging device sensing a media marking on a face of a sheet of print media if the media marking is imprinted on the face of the sheet and sensing a media marking on an edge of a sheet of print media if the media marking is imprinted on the edge of the sheet. Claims 7 and 13 recite similar limitations.

Biegelsen teaches media markings on the edge of the sheets. The Office has interpreted Ueda as teaching media markings on the face of the sheets. The Office asserts that Meunier provides the motivation to combine Biegelsen and Ueda.

Meunier teaches a code marked on the edge of a sheet "uniquely identifying the sheet" and a "Dataglyph" marked on the face of the sheet representing a hash of the edge code and text on the sheet. See, e.g., Meunier column 2, line 60 and column 13, lines 9-25. There is nothing in Meunier that suggests a printer could or should be equipped to read either or both of these markings. In fact, so far as Applicant can tell, Meunier is completely silent as to which device, or even what type of device, reads the Dataglyph. Meunier teaches only that an *edge reader* may be "employed on desktops as individual units or embedded in devices such as facsimile machines, printers, copiers, shredders, etc." Meunier column 7, lines 51-54. Meunier leaves us to guess at which device might read the Dataglyph, when it might be read and how any such reading relates to the information in the edge code.

Applicant acknowledges in the Background section of the Application that it was known in the art to place parameter markings on the face of the sheet or on the edge of the sheet. The problem with these prior art markings, also noted in the Background, is that a printer designed to detect a marking on the face of the sheet cannot detect a marking on the edge of the sheet, and a printer designed to detect a marking on the

edge of the sheet cannot detect a marking on the face of the sheet. Thus, depending on whether media parameter information is marked on the edge or face of the print media, the printer may not be able to detect any media parameters from marked print media. Accordingly, certain print media are relegated to being properly imaged by a subset of all of the possible imaging devices that may have otherwise been able to form a proper image on the media. Specification, page 3, lines 1-14.

Neither Biegelsen nor Ueda recognize this as a problem in the art. Indeed, neither Biegelsen nor Ueda contemplate anything other than marking exclusively on the edge (Biegelsen) or on the face (Ueda). Meunier also does not address this problem or anything even close to this problem. In Meunier, the edge marking and the face marking contain different information and they are used for different purposes. Conspicuously absent from Meunier is any teaching or even any suggestion that the two markings are read by a machine that views the two markings as alternative means to the same information. In the method of Claim 1, by contrast, the printer or other imaging device is looking for media parameter information and it will sense that information whether it is marked on the edge of the sheet or on the face of the sheet.

There is just no reason a person skilled in the art would look to Meunier to solve the problem to which the claims are directed, or otherwise look to Meunier as somehow suggesting that the teachings of Biegelsen and Ueda could or should be combined to reach the claimed invention. With due respect, there is nothing in the Office's remarks discussing Meunier on page 4 of the pending Action that demonstrate the required motivation to combine. If the Office continues to disagree, it is respectfully requested to **explain** how the apparently disparate teachings of Meunier might somehow be reasonably deemed to suggest or motivate combining Biegelsen and Ueda to solve the noted problem (or any other problem for that matter). Simply discussing the teachings of Meunier is by itself not sufficient to prove motivation. The Office must be able to articulate some advantage or beneficial result "[recognized], expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent...." MPEP § 2144, citing *In re Semaker*, 702 F.2d 989, 994-95 (Fed. Cir. 1983). Absent such a showing, the rejections should be withdrawn.

The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

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